

3-1-05

AF *low*

Attorney Docket No. NEX87/PCT-US  
Express Mail Label No. EV 586168653 US

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT:	PAGRATIS ET AL	}	EXAMINER:	FORMAN, B.J.
SERIAL NO.:	10/030,787		ART UNIT:	1634
FILED:	JANUARY 31, 2002			
TITLE:	HIGH AFFINITY TGF $\beta$ NUCLEIC ACID LIGANDS AND INHIBITORS			

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TERMINAL DISCLAIMER RESUBMITTED UNDER 37 C.F.R. § 1.116**

Sir:

A Notice of Appeal was filed on January 31, 2005 along with a 37 C.F.R. § 1.116 submission in which terminal disclaimers in respect of U.S. Pat. No. 6,346,611 and U.S. Pat. No. 6,713,616 were included. The Notice of Appeal fee (\$500) and the fee for the two terminal disclaimers (2 x \$130=\$260) were paid by check at that time. The postcard receipt (which was stamped by OIPE; copy is enclosed) indicates that two terminal disclaimers were submitted; however, it appears that the terminal disclaimer in respect of U.S. Pat. No. 6,713,616 was not received by the Examiner.

In a telephone conversation with attorney Steven Hird on February 28, 2005, the Examiner recommended that the Applicants resubmit the terminal disclaimer in respect of U.S. Pat. No. 6,713,616. A copy of the terminal disclaimer filed January 31, 2005 in respect of U.S. Pat. No. 6,713,616 is therefore enclosed. As the fee for two terminal disclaimers was paid by check on January 31, 2005, it is believed that no fee is required for this resubmission.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117, if not otherwise specifically requested. The

undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,

Date: February 28, 2005



---

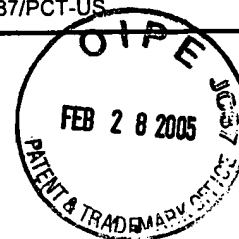
Steven N. Hird, #51,112  
Swanson & Bratschun, L.L.C.  
1745 Shea Center Drive, Suite 330  
Highlands Ranch, Colorado 80129  
Telephone: (303) 268-0066  
Facsimile: (303) 268-0065

S:\CLIENTFOLDERS\GILEAD (FORMERLY NEXSTAR)\NEX87\PCT\US\NEX87US SUPP 116 (TERM DISCLAIMER).DOC

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# **TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT**

Docket Number (Optional)  
NEX87/PCT-US



In re Application of: PAGRATIS, ET AL.

Application No.: 10/030,787

Filed: JANUARY 31, 2002

For: HIGH AFFINITY TGF $\beta$  NUCLEIC ACID LIGANDS AND INHIBITORS

The owner\*, GILEAD SCIENCES, INC., of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term **prior patent** No. 6,713,616 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said **prior patent** is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the **prior patent** are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the **prior patent**, "as the term of said **prior patent** is presently shortened by any terminal disclaimer," in the event that said **prior patent** later:

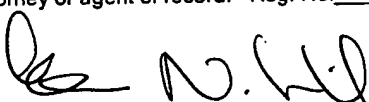
- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of a business/organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the business/organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record. Reg. No. 51,112

  
\_\_\_\_\_  
Signature

JANUARY 31, 2005  
Date

STEVEN N. HIRD  
Typed or printed name

303-268-0066  
Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



**DATE:** January 31, 2005  
**APPLICANT:** PAGRATIS *ET AL.*  
**SERIAL NO.:** 10/030,787  
**FOR:** HIGH AFFINITY TGF $\beta$  NUCLEIC  
ACID LIGANDS AND INHIBITORS

**RECEIPT IS HEREBY ACKNOWLEDGED OF:**

Notice of Appeal (4pgs.); Executed Declaration – Pagratis (1pg.);  
Terminal Disclaimer - USPN 6,346,6111 (1pg.); Terminal Disclaimer –  
USPN 6,713,616 (1pg.), and Check in the amount of \$760.00.



Attorney Docket No.: NEX87/PCT-US  
Express Mail Label No. EV586169486 US